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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/731,758

Applicant(s)

FACCIN ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1> This action is in response to Applicant's amendment, filed, 10.12.2006. Claims 1-84 are amended. Claim 85 is added. Claims 1-85 are presented for further examination.

2> This is a final rejection.

### *Terminal Disclaimer*

3> The terminal disclaimer filed on 10.12.2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S Patent No. 6,725,036 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Response to Arguments*

4> Applicant has substantively amended independent claims with two new limitations:

(1) wherein an application level registration message including the identification of the subscriber is generated in response to a request from a subscriber equipment to the visited network; and (2) wherein the visited network receiving the request transmits an update location message to the home network for informing the home network of the identification of the subscriber and a particular network at which the subscriber is located. Applicant's arguments have been considered but are moot in view of the new grounds of rejection set forth in this action.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5> Claims 1, 34, 37, 68, 78 and 85 are rejected under 35 U.S.C §102(e) as being anticipated by Bharatia, U.S Patent Publication No. 2001|0031635.

6> As to claim 85, Bharatia discloses an apparatus, comprising:

sending means for sending, from a visiting network of a plurality of networks connected to a home network, an identification of the subscriber and an access to be provided to the subscriber [0081, 0111 : subscriber identification, services supported];

in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profile of an authorized access of a plurality of authorized accesses to be provided to the subscriber [0078, 0081 : receives profile information]; and

controlling means for controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber

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profile having the authorized access of the plurality of authorized accesses [0081 : based upon subscriber information, service services such as call control and messaging are supported];

generating means for generating an application level registration message including the identification of the subscriber in response to a request from a subscriber equipment to the visited network [0077, 0111-0116 : "application level registration requests"];

transmitting means for transmitting, in the visited network receiving the request, an update location message to the home network for informing the home network of the identification of the subscriber and a particular network at which the subscriber is located [0015, 0102, 0141].

7> As to claims 1, 34, 37, 68, 78, see rejection of claim 85, above.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8> While all claims have been amended, only those claims that have been substantively amended by Applicant are formally addressed in this action. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 1.30.2006.

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9> Claims 1-31 and 34-85 rejected under 35 U.S.C 103(a) as being unpatentable over Pepe et al, U.S Patent No. 5.742.668 ["Pepe"], in view of Rune et al, U.S Patent No. 6.611.685 ["Rune"].

10> As to claims 1 and 85, Pepe discloses a method and apparatus of controlling access of a subscriber to a network comprising:

sending, from a visiting network of a plurality of networks connected to a home network, an identification of the subscriber and an access to be provided to the subscriber [column 2 «lines 19-37» | column 6 «lines 47-52»: provision of identification is implicit in order to retrieve the correct profile from home network];

in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profile of an authorized access of a plurality of authorized accesses to be provided to the subscriber [column 2 «lines 19-37»]; and

controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber profile having the authorized access of the plurality of authorized accesses [column 2 «lines 19-37» | column 6 «lines 11-27» and 47-52»];

wherein an application level registration message including the identification of the subscriber is generated in response to a request from a subscriber equipment to the visited network [column 15 «line 66» to column 16 «line 35» : where the registration message includes the subscriber ID].

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Pepe discloses updating the location of the subscriber at the home network [column 2 «lines 31-37» : “updating the visiting location of a user in the HLR (home location register)”] but does not expressly disclose an update location message.

11> Rune expressly discloses an update location message that is sent to a home network and informs the home network of the identification of the subscriber and a particular network at which the subscriber is located [column 6 «lines 23-40» : “update\_location message”]. It would have been obvious to incorporate Rune’s messaging functionality into Pepe’s system. One would have been motivated to provide such a combination because such functionality is well known in the art for updating home networks as to the location of subscribers and to properly access what services are available to the subscribers.

12> As to claims 34, 37, 68 and 78, see rejection of claim 1.

13> Claims 32 and 33 are rejected under 35 U.S.C § 103(a) as being unpatentable over Pepe, in view of Hoffman, U.S Patent No. 6,148,199.

14> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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15> Claims 1, 34, 37, 68 and 78 rejected under 35 U.S.C §103(a) as being unpatentable over Lahtinen et al, U.S Patent No. 6.745.029 ["Lahtinen"] in view of Akhtar et al, U.S Patent No. 6.769.000 ["Akhtar"].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

16> As to claim 1, Lahtinen discloses a method of controlling access of a subscriber to a network comprising:

sending, from a visiting network of a plurality of networks connected to a home network, an identification of the subscriber and an access to be provided to the subscriber

[column 3 «lines 8-26» : provisioning of subscriber identification is implicit in order to correctly transfer the user's information];

in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profile of an authorized access of a plurality of authorized accesses to be provided to the subscriber [column 3 «lines 20-34»]; and

controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber profile having the authorized access of the plurality of authorized accesses [column 7 «lines 44-50» : profile information contains whether a user is authorized to user services. Comparison feature is implicit.].

Lahtinen does not expressly disclose an application level registration message or an update location message.

17> Akhtar discloses both: (1) wherein an application level registration message including the identification of the subscriber is generated in response to a request from a subscriber equipment to the visited network [Figures 20L, 20M | column 31 «line 56» to column 32 «line 23» : the registration message containing identification for the subscriber]; and

(2) wherein the visited network receiving the request transmits an update location message to the home network for informing the home network of the identification of the subscriber and a particular network at which the subscriber is located [column 22 «lines 53-59» | column 32 «lines 11-15» : "location update messages", the home register updating the location of the particular subscriber].

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It would have been obvious to one of ordinary skill in the art to incorporate Akhtar's registration and location update messages into Lahtinen. One would have been motivated to combine the references to improve Lahtinen's ability to register and update the location of visiting nodes.

18> As to claims 34, 37, 68 and 78, see rejection of claim 1.

19> Claims 1, 34, 37, 68 and 78 rejected under 35 U.S.C §103(a) as being unpatentable over Hoffman, in view of Roy, U.S Patent No. 6.947.432.

20> As to claim 1, Hoffman discloses a method of controlling access of a subscriber to a network comprising:

sending, from a visiting network of a plurality of networks connected to a home network, an identification of the subscriber and an access to be provided to the subscriber [column 1 «lines 31-47»];

in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profile of an authorized access of a plurality of authorized accesses to be provided to the subscriber [column 1 «lines 31-47»]; and

controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber profile having the authorized access of the plurality of authorized accesses [column 1 «lines 31-47» | column 3 «lines 60-64»]

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: comparison feature is implicit based on Hoffman's teaching of access privileges for the subscriber].

Hoffman does not expressly disclose an application level registration message or an update location message.

21> Roy discloses both: (1) wherein an application level registration message including the identification of the subscriber is generated in response to a request from a subscriber equipment to the visited network [Figure 4 | column 8 «line 43» to column 9 «line 10» : updating the location of the interzone mobile entity]; and

(2) wherein the visited network receiving the request transmits an update location message to the home network for informing the home network of the identification of the subscriber and a particular network at which the subscriber is located [Figure 4 | column 9 «line 62» to column 10 «line 62»].

It would have been obvious to one of ordinary skill in the art to incorporate Roy's registration and location update messages into Hoffman. One would have been motivated to combine the references to improve Hoffman's ability to register and update the location of visiting nodes.

22> As to claims 34, 37, 68 and 78, see rejection of claim 1.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

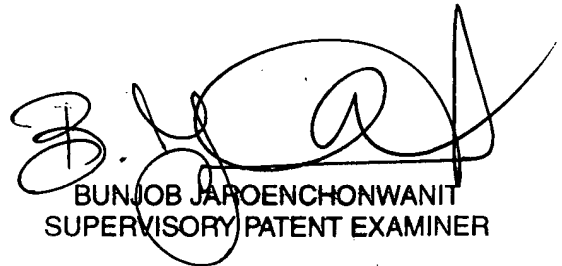
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



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SUPERVISORY PATENT EXAMINER